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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,894	11/13/2001	Scott Lascelles	132538-1016	4186
32914 7590 12/12/2007 GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761			EXAMINER MALHOTRA, SANJEEV	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/991,894

Applicant(s)

LASCELLES ET AL.

Examiner

Sanjeev Malhotra

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Acknowledgments

1. The Examiner for this application has changed with effect from November 15th, 2007. Please indicate Examiner Sanjeev Malhotra as the examiner of record in all future correspondence.

DETAILED ACTION

2. This is the Final Office Action in response to the Amendment, Remarks/ Arguments filed by the Applicant on July 19th, 2007 for its application titled: "On-Line Balance Transfers". Claims 1-17 are currently pending in this application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, at least independent Claims 1, 14, 16 and 17 contain a conditional statement "if" that only explains one side. To make the claim clear, it must describe "'if' yes" and "'if' no" statements. Additionally, independent Claims 1, 14, 16 and 17 fail to positively recite the

limitations in the third step of these claims. Examiner provides alternative language as a suggestion only, for example, the third step of Claim 1 could be re-written as: “denying the request of the account holder for online transfer of balance from the first credit account to the second credit account as being ineligible once it has been determined that the first credit account is held with a financial institution that is related to the financial institution with which the second credit account is held;” and a follow-up step could be added to actually describe the actual purpose of this “method for online transfer of a balance”, such as: “approving the request of the account holder for online transfer of balance from the first credit account to the second credit account as being eligible once it has been determined that the first credit account is held with a financial institution that is not related to the financial institution with which the second credit account is held;” and this alternative language ties the steps of this independent Claim 1 together. Similarly, the third step of Claim 14 could be re-written as: “deny the request of the account holder for online transfer of balance from the first credit account to the second credit account as being ineligible once it has been determined that the first credit account is held with a financial institution that is related to the financial institution with which the second credit account is held;” and a follow-up step could be added to actually describe the actual purpose of this “method for online transfer of a balance”, such as: “approve the request of the account holder for online transfer of balance from the first credit account to the second credit account as being eligible once it has been determined that the first credit account is held with a financial institution that is not related to the financial institution with which the second credit account is held;” and this alternative language ties the steps of this independent Claim 14 together, and the currently recited step of “a network connection” will follow this step. Similarly, third steps of the

independent Claims 16 and 17 can be recited based on alternative language shown above for the third step of independent Claims 1 and 14.

Claim 8 is missing some words at the end of its current recitation (and a phrase suggested by the Examiner is shown in parentheses at the end): “..... with the financial institution with which the second credit account. (is held)”, and it needs correction by the Applicant.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In particular, at least the independent claims 1,14, 16 and 17 have no tangible action that is concluded. A final action step such as “transferring funds” needs to be specified, or a similar final action step confirming the completion of such transfer of balance (funds) from the first credit account to the second credit account needs to be specified.

Corrective action to claims is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17, as best understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Walker US Patent 6,267,292 B1 claiming priority from June 13, 1997 and titled: "Method and Apparatus for Funds and Credit Line Transfers".

Re claim 1, 14, 16 & 17: Walker discloses:

A method & system comprising:

Obtaining account data (associated with first credit account) comprising at least financial institution where account is held (see Walker, Figure 8A, Item 810)

Determining if financial institution (of first credit account) is related to financial institution (of second credit account) (see Walker, Figure 8A, Item 825)

If true – identifying first credit account as being not eligible for a balance transfer to second credit account (see Walker, Figure 8A, Item 830)

Re claim 2: Walker discloses:

Account data obtained in real time (see Walker, Figure 3, Item 345 it is inherent with a database that it is done in real time)

Re claim 3 & 4: Walker discloses:

Account data is obtained from a source other than account holder = credit reporting bureau (see Walker, Figure 8B, Item 850)

Re claim 5: Walker discloses:

Financial institution related if first account is held is same as where second account is held (see Walker, Figure 8A, Item 825)

Re claim 6: Walker discloses:

Financial institution related if first account is held is affiliated as where second account is held (see Walker, Figure 8A, Item 825)

Re claim 7: Walker discloses:

Step of determining comprises comparing the financial institution with which the first credit account is held with a list of ineligible financial institutions (see Walker, Figure 8A, Item 825)

Re claim 8: Walker discloses:

List of ineligible financial institutions comprises the financial institution with which the second credit account is held and any financial institutions associated with the financial institution with which the second credit account (see Walker, Figure 8A, Item 825)

Re claim 9: Walker discloses:

Receiving from account holder an indication that the account holder is interested in transferring a balance to the second credit account

Obtaining account data is preformed in response to indication (see Walker, Figure 9, Item 120)

Re claim 10: Walker discloses:

Displaying at least a portion of account data to the account holder (see Walker, Figure 12A, Item 1215)

Re claim 11: Walker discloses:

Displaying at least a portion of account data to the account holder in the event it is determined that the financial institution with which the first credit account is held is not the same as or associated with the financial institution with which the second credit account is held (see Walker, Figure 12A, Item 1225)

Re claim 12: Walker discloses:

Providing to the account holder a balance transfer request display, The display comprising data entry field, Populating the data entry field with at least one element of account data (see Walker, Figure 8A, Item 1275)

Re claim 13: Walker discloses:

Providing to account holder a balance transfer request display

Display comprising a data entry field

In the event it is determined that the financial institution with which the first credit account is held is not the same as or associated with the financial institution with which the second credit account is held, populating the data entry field with at least one element of account data (see Walker, Figure 8A, Item 1275)

Re claim 15: Walker discloses:

Computer system comprise two or more computers (see Walker, Figure 2)

Response to Arguments

6. Applicant's REMARKS and Arguments dated July 19, 2007 with respect to Claims 1-17 have been considered, but they are not persuasive.

In the last Office Action mailed on January 19, 2007, the Examiner of record put forth the arguments for rejection of Claims 1-17; and current Examiner maintains the argument of the previous examiner(s), and disagrees with the arguments submitted. Further, the current Examiner clarifies that the transfer taught by Walker et al. is from a first credit account number to a second credit card account number, which is the same as is being claimed by the Applicants as far as these account numbers are not related by being owned by the same financial institution (or the same banking entity). Thus, the Applicants argument about Walker's teaching is not persuasive, as the transfer between the accounts of a "transferor" and a "transferee" is accomplishing the very same thing that the Applicants are claiming by the broad language recited in their claims.

Further, the Applicants state in their arguments: "Each of the Claims 1-17, either expressly or by dependency, requires a determination be made as to whether the issuing banks are related, and that a determination of ineligibility be made if it is determined that they are related." The current Examiner has carefully searched the currently recited Claims 1-17, and has found no basis for these arguments by the Applicants as the currently recited Claims 1-17 do not contain the following terms searched by the current Examiner: "issuing bank", "bank", "determination of ineligibility", "determining ineligibility", "determine ineligibility" or "ineligibility", and thus these Claims may require some amendment to be consistent with the arguments. Additionally, as requested, the current Examiner has provided alternative language for the Applicants consideration, but

this suggested language does not guarantee an approval of this patent application should the Applicants choose to include it in their amended claims.

Further, the Applicants are informed that the references cited in the rejection of claims must be read in entirety as other passages and drawings may also apply, for example, but not limited to, Walker's teachings contained in FIGs. 8A and 8B and their text relate to 'General Funds Transfers', FIGs. 9/10A/10B and text relate to 'Payment of Debt', FIGs. 11/12A/12B and text relate to 'Purchase of Goods or Services', FIGs. 13/14A/14B and text relate to 'Secure (Transfer) Transactions', FIGs. 15-19/20A/20B and text relate to '(Secure) credit line transfers (Transactions)', and FIGs. 21/22A/22B and text relate to the 'selling of unused credit line' by the user/transferor, and that the drawings used for 'General Funds Transfers' provide the basis and general framework for all the other drawings that follow.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

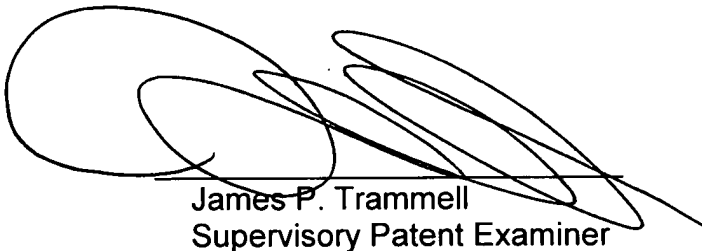
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

SM
December 3, 2007



James P. Trammell
Supervisory Patent Examiner